

No. 18249 ✓

IN THE

See Vol. 3197

United States Court of Appeals

FOR THE NINTH CIRCUIT

HAMMERMILL PAPER Co., a corporation, substituted
for COAST ENVELOPE COMPANY, doing business as
COAST BOOK COVER Co.,

Plaintiff-Appellant,

vs.

THE ARDES COMPANY, a corporation,

Defendant-Appellee.

PETITION FOR REHEARING.

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PETITION FOR REHEARING.

Appellant respectfully petitions for a rehearing of this case, which was decided on June 25, 1963. The grounds upon which the petition is based are that:

1. The Court has invalidated the highly successful, although limited, Miller patent in suit, which has been respected by the entire industry for over thirteen years, by accepting the *admittedly speculative* conclusions of appellee's biased expert as to the disclosure of the prior Rockwell patent [Ex. A-2], in lieu of drawing its own conclusions from the patent itself, which is simple and certainly required no expert explanation.

*National Sponge Cushion Co. v. Rubber Corp.
of Calif.*, 286 F. 2d 731, Ninth Circuit.

“A patent relied upon as an anticipation must itself speak and its specification must give in substance the same knowledge and same directions as the specification of the patent in suit.”

*Cold Metal Process Co. v. Carnegie-Illinois Steel
Corp.*, 108 F. 2d 322, 333, Third Circuit;
Walker, Deller's Edition, page 270.

2. This Court's ruling constitutes a precedent which, if allowed to stand, seriously endangers the future of our patent system, since it sanctions acceptance of admittedly speculative conclusions of an adverse expert as to the disclosure of an alleged anticipatory patent, despite the fact that the conclusions are not borne out by the disclosure of the patent document itself.

ARGUMENT.

The Court's opinion states:

"Defendant's expert witness testified that the right hand edge of the 'clip' in the Rockwell patent is tapered, and 'that tapered portion continues down to the terminating edge which is disposed vertically relative to the base portion'."

However, this Court apparently failed to note that appellee's expert did not make that statement as a positive fact, but admitted that the Rockwell patent disclosure was of such small scale as to cause him to "wonder" as to what it did show. For instance, when he was asked on cross-examination [R. 147-148] to point out where the Rockwell patent drawing showed a downwardly disposed edge intersecting the side in a taper, he admitted:

"Well, I wondered about that. I think there may be a suggestion of a taper on the right hand end. Of course the scale of that drawing is rather small and the amount of that—the extent of the lip is really quite short in comparison with the thickness of a line and I admit it is hard to determine from the drawing of Figure 1 whether there is a taper there—whether the taper is actually shown."

Moreover, the Rockwell patent drawing actually shows the side edge of the wall designated as 23 as being the only part which is tapered and cut away, to provide the upturned flange designated as 26. The

wall 23 of the Rockwell patent, in the nomenclature of its specification, is called the front wall or flange merely because the Rockwell patent specification describes the clip as it would appear in a vertical position, that is, with its base portion considered in vertical as distinguished from horizontal position. On the other hand, in the nomenclature used in the Miller patent in suit, appellant's clip is described as it would appear when considered in horizontal position. The wall designated as 24 in the Rockwell patent is therefore actually the *front* wall if interpreted in accordance with the nomenclature of the Miller patent.

This Rockwell patent was not discussed in particular detail at the hearing of this appeal simply because the defendant was there relying principally upon the British patent to Bonnet, No. 17932 [Ex. A-1] as being anticipatory. As pointed out in Appellant's Opening Brief herein, the appellee tried and abandoned the Bonnet structure prior to adopting the accused structure.

The Rockwell patent specification (p. 1, column 2, lines 59-67) states:

"The lower edge of this front flange (23) is bent back as at 24 to form the double function of holding the pad in conjunction with the picket-edge 17, as presently will be described, and of forming a *cutting edge* for the leaves of the pad. At one side 25 the front flange is cut away and is curved outward as at 26."

There it will be noted that only the wall 23, which is the top wall, is described as being cut away. The vertically disposed wall 24 is nowhere described or shown as being cut away or beveled.

A clear illustration of the disclosure of the Rockwell patent is found in the fully authenticated [R. 194] physical model [Ex. 17].

In any event, by reference to Fig. 1 of the Rockwell patent (which is a perspective view showing the Rockwell device as viewed from the left front), it will be seen that the downwardly disposed or vertical wall 24 is defined by two *parallel* lines, which certainly would not indicate any bevel or curve.

Obviously, what appellee's expert has done is to do a bit of wishful thinking. With full knowledge of the teachings of the successful Miller patent in mind, he has tried to use that knowledge in reconstructing the Rockwell patent disclosure to verbally change it into an anticipating structure when, in fact, it is not.

Wherefore, appellant respectfully submits that, in the interests of justice, this petition should be granted.

Dated: July 24, 1963

COLLINS MASON and
A. DONHAM OWEN,
By COLLINS MASON,
Attorneys for Appellant.

Certificate of Counsel.

I, Collins Mason, counsel for Petitioner in the above entitled action, hereby certify that the foregoing petition for rehearing of this cause is presented in good faith and not for delay, and in my opinion is well founded in law and in fact, and proper to be filed herein.

COLLINS MASON,
Attorney for Petitioner.

Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

COLLINS MASON,

